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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR			ATTORNEY DOCKET NO.

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NGU, EXAMINER

ART UNIT 1202 PAPER NUMBER

12/04/97

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), - days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-17 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-16(A) are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 17 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☒ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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FIRST ACTION ON MERIT

Applicant's election with traverse of Group I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the intermediates of claim 17 are closely related to compounds in claim 1 - 15. This is partially persuasive because only **formula II** of claim 17 is related to group I while the other formulae are not related to group I since process 16(A) does not require them. Note that the invention is restricted because of **multiple processes** in claim 16. If the examiner was to follow rule 37 CFR 1.475 paragraph (d) strictly, then the first process would have been examined automatically without presenting the restriction to the applicant. However, in the instant case, the restriction was presented to give the applicant a chance to select the most pertinent process. As far as the intermediates are concerned, it would be fair to consider only formula II with group I as the remaining intermediates belong to the non-elected subject matters. Furthermore, formulae III - VIII, and X are either monocyclo, bicyclo, or tricyclo with different functional groups, and they are classified in various classes which will incur an extensive search, not to mention a separate on-line literature search is required for each. Thus, if the applicant agrees to delete formulae III - VIII and X from claim 17, the examiner will be more than willing to consider formula II of claim 17 as a part of Group I.

The requirement is still deemed proper and is therefore made FINAL.

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Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in United Kingdoms (UK) on January 21, 1994. It is noted, however, that applicant has not filed a certified copy of the UK application as required by 35 U.S.C. 119(b).

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of non-provisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

Claim Rejections - 35 USC § 112

Claims 1 - 16(A) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

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1. The phrase, "R¹ and R³ together represent.....alkyl or alkenyl chain", is not clear as to how a chain can be formed from the two substituents. Perhaps, a ring is intended.
2. The phrase, "**and** salts **and** solvates...", suggests multiple forms of formula (I) in one compound which probably are not intended so.

Claims 11 and 12 provide for the use of formula (I), but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims '11 and 12 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Scope of Enablement: Claims 1 - 16(A) are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for formula (I) with R¹ and R³ are independent from each other, does not reasonably provide enablement for formula (I) with R¹ and R³ together form a chain. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the invention commensurate in scope


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with these claims. It is virtually impossible for R^1 and R^3 to form a chain together. No chemical reactions are known to synthesize such a structure. No generic teachings or examples are provided to guide one skilled in the art to make compounds of formula (I) with R^1 and R^3 together form a chain. In re Howarth, 210 USPQ 689.

A search in the pertinent art areas does not yield any additional references other than those cited on the IDS submitted by the applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Tamthom (or Tam) Ngo whose telephone number is (703) 305 - 4485. The examiner can normally be reached on Monday thru Friday from 8:30 am to 5:00 pm EST.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 - 1235.


T. Ngo / 11-26-97


MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 1200